

## **REMARKS**

### **I. Introduction**

Applicant submits the present Amendment in response to the non-final Office Action mailed November 12, 2008. Applicant sincerely appreciates the thorough review of the present application that is reflected in the Office Action. In response to the Office Action, Applicant has cancelled Claims 1, 7, 10, 12, 26, 28, 33 and 35. Applicant has also rewritten Claim 2 into independent form, amended Claims 11, 27 and 29, and revised the dependencies of Claims 6, 8, 31 and 34. Applicant has also added new Claims 36-39. In light of the above claim amendments and the following remarks, Applicant respectfully submits that all of the claims are now in condition for allowance, which is respectfully requested.

### **II. The Rejections Under 35 U.S.C. 102**

Claims 1-5, 7-12 and 26-29 stand rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Publication No. EP 1096813 A2 to Koskinen et al. ("Koskinen"). (Office Action at 2). As noted above, Applicant has cancelled Claims 1, 7, 10, 12, 26 and 28, mooted the rejections of those claims. Applicant respectfully submits that the remaining claims, as amended herein, are patentable over Koskinen.

#### **A. The Rejection of Claim 2**

Claim 2, which has been rewritten into independent form but otherwise has not been amended, recites:

2. A method for a wireless terminal participating in a packet-switched communications session to provide notice of receipt of an incoming circuit-switched call, the method comprising:

receiving a paging request associated with the incoming circuit-switched call;  
and

notifying a server associated with the packet-switched communications session that the wireless terminal has received the incoming circuit switched call,

wherein notifying the server associated with the packet-switched communications session that the wireless terminal has received the incoming circuit switched call comprises forwarding a notification message from the wireless terminal to the server **over a circuit-switched channel**.

Applicant respectfully submits that Koskinen does not disclose "forwarding a notification message from the wireless terminal to the server over a circuit-switched channel" and, as such, the rejection of Claim 2 as anticipated by Koskinen should be withdrawn.

In particular, the Office Action cites to Col. 6, lines 25-29 of Koskinen as allegedly disclosing the above-quoted recitation from Claim 2. (Office Action at 3). The cited portion of Koskinen states that the wireless terminal disclosed therein "is equipped with means for setting up both a circuit-switched connection (CS) and a packet-switched connection to the mobile communication system." (Koskinen at Col. 6, lines 25-29). This statement, however, does **not** teach sending a notification to a server associated with the packet-switched communications session that the wireless terminal has received the incoming circuit switched call over a circuit switched channel as is expressly recited in Claim 2. Instead, Koskinen simply states that the mobile terminal disclosed therein has both circuit switched and packet-switched communications means. In fact, it appears that Koskinen teaches directly away from the method of Claim 2. Specifically, Koskinen teaches at blocks 107-109 of Fig. 1a and the description thereof that the wireless terminal sends a "No Operation" message to the server over the packet-switched connection as opposed to over a circuit-switched connection. (Koskinen at Col. 7, line 56 through Col. 8, line 15 and Fig. 1a). Thus, for the above reasons, Applicant respectfully submits that Koskinen does not anticipate Claim 2, and hence the rejection of Claim 2 should be withdrawn.

**B. The Rejection of Claims 2-5 and 8-9**

Claims 3-5 and 8-9 each depend from Claim 1, and hence are patentable over Koskinen as depending from a patentable base claim. Additionally, Applicant respectfully submits that at least Claims 3-5 and 9 are independently patentable over Koskinen.

In particular, Claim 3 recites, among other things, that the "circuit-switched channel is the SMS data bearer." The Office Action cites to Col. 1, lines 37-42 and Col. 6, lines 22-29 of Koskinen as disclosing the recitations of Claim 3. (Office Action at 3). However, the passage at Col. 1, lines 37-42 of Koskinen simply states that GPRS service supports Short Message Service transmissions. This passage from Koskinen clearly does **not** teach forwarding a notification message from the wireless terminal to the server over the SMS data bearer channel as is expressly recited in Claim 3. Likewise, as discussed above with respect

to the rejection of Claim 2, Col. 6, lines 22-29 of Koskinen merely states that the mobile terminal disclosed therein has both circuit switched and packet-switched communications means. Thus, as neither of the cited portions of Koskinen disclose the recitations of Claim 3, Claim 3 is independently patentable over Koskinen, as are Claims 4 and 5 which depends therefrom.

Claim 4 recites that "the notification message comprises a text message or an e-mail message transmitted over the SMS data bearer." The Office Action cites to Col. 1, lines 37-42 of Koskinen as disclosing the recitations of Claim 4. (Office Action at 3). However, as noted above, this passage of Koskinen simply states that GPRS service supports Short Message Service transmissions, and clearly does not teach that the notification message forwarded over the SMS data bearer channel comprises a text message or an e-mail message as is expressly recited in Claim 4. Thus, Claim 4 is independently patentable over Koskinen for this additional reason.

Claim 5 recites that "the notification message is forwarded via an IP level connection over the SMS data bearer." Once again, the Office Action cites to Col. 1, lines 37-42 of Koskinen as disclosing the recitations of Claim 5. (Office Action at 3). However, the cited passage from Koskinen says nothing about forwarding a notification message to a server associated with a packet-switched communications session that the wireless terminal has received the incoming circuit switched call "via an IP level connection over the SMS data bearer" as is expressly recited in Claim 5. Thus, Claim 5 is independently patentable over Koskinen for this additional reason.

Claim 9, in conjunction with its dependency from Claim 8, recites "notifying the server associated with the packet-switched communications session upon termination of the incoming circuit-switched call," where the notification "is forwarded over a circuit-switched channel." The Office Action cites to Col. 6, lines 25-29 and Col. 9, lines 41-47 of Koskinen as disclosing the recitations of Claim 9. (Office Action at 4). However, the cited portions of Koskinen do not disclose or suggest forwarding a notification to the server associated with the packet-switched communication over a circuit-switched channel as is recited in Claim 9. Thus, Claim 5 is independently patentable over Koskinen for at least this reason.

C. The Rejection of Claim 11

Claim 11, which has been amended and rewritten into independent form, recites:

11. A method for a wireless terminal participating in a packet-switched communications session to provide notice of receipt of an incoming circuit-switched call, the method comprising:

receiving a paging request associated with the incoming circuit-switched call;

notifying a server associated with the packet-switched communications session that the wireless terminal has received the incoming circuit switched call and;

notifying a remote terminal that the wireless terminal has temporarily suspended participation in the packet-switched communications session,

wherein the packet-switched communications session comprises a push-to-talk session, and

wherein the remote terminal is another wireless terminal that was part of the push-to-talk session.

The Office Action cites to Fig. 1a, Col. 7, line 56 through Col. 8, line 13 of Koskinen as disclosing the recitations of Claim 11. Applicant respectfully traverses the rejection of Claim 11 for at least two reasons.

First, as amended, Claim 11 recites that "the packet-switched communications session comprises a push-to-talk session." Koskinen does not disclose or suggest notifying a push-to-talk session server that a wireless terminal that was part of the push-to-talk session has received an incoming circuit switched call. Thus, the rejection of Claim 11 should be withdrawn for this reason.

Second, the cited portions of Koskinen do not disclose "notifying a remote terminal that the wireless terminal has temporarily suspended participation in the packet-switched communications session" as is recited in Claim 11. Claim 11 has been amended to clarify that "the remote terminal is another wireless terminal that was part of the push-to-talk session." The cited portions of Koskinen discuss notifying a packet-switched server, but do not discuss notifying another wireless terminal that was part of the push-to-talk session that the push-to-talk session has been suspended. Accordingly, the rejection of Claim 11 as anticipated by Koskinen should also be withdrawn for this reason.

D. The Rejection of Claim 27

Claim 27, which has been amended and rewritten into independent form, recites:

27. A wireless terminal, comprising:

a transceiver; and

a packet-switched suspension notification circuit coupled to the transceiver that is configured to generate a notification message that is suitable for transmission as an e-mail message or a test message over a circuit switched SMS data bearer to a server controlling a packet-switched communications session when the wireless terminal temporarily suspends participation in the packet-switched communications session, and

a circuit-switched communications circuit, wherein the packet-switched suspension notification circuit generates the notification message in response to receipt of a circuit-switched page by the circuit-switched communications circuit.

The Office Action states that Fig. 2a, and Col. 7, line 56 through Col. 8, line 13 of Koskinen discloses all of the recitations of Claim 27. As amended, Claim 27 recites that the packet-switched suspension notification circuit "is configured to generate a notification message that is suitable for transmission as an e-mail message or a test message over a circuit switched SMS data bearer to a server controlling a packet-switched communications session." As discussed above with respect to the rejections of Claims 2-4, Koskinen does not disclose any such packet-switched suspension notification circuit. Accordingly, the rejection of Claim 27 should be withdrawn for this reason.

E. The Rejection of Claim 29

Claim 29, as amended, recites:

29. A computer program product implemented in a wireless terminal that is participating in a packet-switched communications session that provides notice of receipt of an incoming circuit-switched call, comprising:

a computer readable medium having computer readable program code embodied therein, the computer readable program code comprising:

computer readable program code configured to receive a paging request associated with the incoming circuit-switched call;

computer readable program code configured to notify a server associated with the packet-switched communications session via a text message or an e-mail message that is transmitted over a circuit-switched SMS data bearer channel that the wireless terminal has received the incoming circuit switched call; and

computer readable program code configured to notify the server associated with the packet-switched communications session over the circuit-switched SMS data bearer channel upon termination of the incoming circuit-switched call.

Applicant respectfully submits that Koskinen does not disclose either of the last two recitations of Claim 29, as is discussed above with respect to various of the other claims. Accordingly, the rejection of Claim 29 as anticipated should be withdrawn.

### **III. The Rejections Under 35 U.S.C. 103**

Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Koskinen in view of U.S. Patent Publication No. 2005/0041640 to Nasielski et. al. ("Nasielski"). (Office Action at 6). Claims 31-35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Koskinen in view of U.S. Patent Publication No. 2005/0169223 to Crocker et. al. ("Crocker"). (Office Action at 7). Claims 3 and 35 have been cancelled. Applicant respectfully submits that the remaining claims, as amended herein, are patentable over Koskinen.

In particular, each of Claims 6 and 31-32 and 34 depend either directly or indirectly from Claim 2, and hence is patentable as depending from a patentable base claim. Applicant also respectfully submits that at least Claims 6 and 34 are independently patentable over the cited art.

Claim 6 recites that "the notification message includes an identification associated with the wireless terminal and/or an estimate of the length of the incoming circuit-switched call." The Office Action cites to Nasielski at ¶ 0032, lines 6-9 as disclosing the recitations of Claim 6. The cited portion of Nasielski teaches that the Internet Protocol address of a wireless terminal **102** may be appended to a notification message forwarded by a voice message server **110** (e.g., a voicemail server) "so that the PDSN **114** can route the notification to the intended subscriber station **102** using the existing packet data session." (Nasielski at ¶ 0032). However, as is clear from a review of Nasielski, the notification message discussed therein is a notification message that is forwarded from a packet data serving node **114** to the voice message server **110**. As such, this notification is clearly not from "the wireless terminal" as is the notification message of Claim 6 and, in fact, the only reason that the IP address of the wireless terminal is appended to the notification is so that the

packet data serving node **114** will know where to route the notification. As such, Nasielski clearly does not teach the recitation of Claim 6, nor does the cited combination of Nasielski and Koskinen result in the method of Claim 6.

Claim 34 recites that "the circuit-switched channel is the SMS data bearer." As discussed above with respect to the rejection of Claim 3, Koskinen does not disclose notifying a server associated with the packet-switched communications session that a wireless terminal has received an incoming circuit switched call "over a circuit-switched channel" as is recited in Claim 34. As such, Claim 34 is independently patentable over the cited art.

#### **IV. New Claims 36-39**

Applicant has added new Claims 36-39 to the application. Applicant respectfully submits that each of these new claims are patentable over the cited art.

#### **V. Conclusion**

For the above reasons, Applicants respectfully submit that the present application is in condition for allowance, which is respectfully requested.

Respectfully submitted,



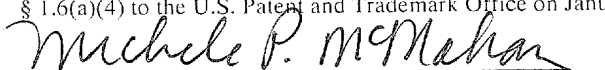
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#### **CERTIFICATION OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on January 19, 2009.

  
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